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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/701,315   | 01/09/2001  | Jeremy Carver        | 12243.15USWO        | 8757             |
| 23552  | 7590        | 04/26/2006           | EXAMINER            |                  |
| MERCHANT & GOULD PC<br>P.O. BOX 2903<br>MINNEAPOLIS, MN 55402-0903 |             |                      | TRAN, MY CHAU T     |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             | 1639                 |                     |                  |

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|---------------------------------|-------------|---|---------------------|
| APPLICATION NO./<br>CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR /<br>PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
| 09/701,315                      | 1/09/2001   | Jeremy Carver et al.                              | 12243.15 USWO       |
| EXAMINER                        |             |   |                     |
| M. TRAN                         |             |   |                     |
| ART UNIT                        | PAPER       |   |                     |
| 1639                            | 14          |   |                     |

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**Commissioner of Patents and Trademarks**

Application No.: 09/701,315

Art Unit: 1639

NOTE: The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1639.

1. Applicant's election without traverse of Group I (Claims 1-6) in Paper No. 11 is acknowledged in the previous Office Action.
2. Applicant's election without traverse of species for X and R in Paper No. 13, where X is hydrogen and R is -NHCOR1 is acknowledged. Applicant further indicated that m is 2 and Claims 1-6, 18, and 19 read on the elected species.
3. The reply filed on 9/12/02 (Paper No. 13) is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):  
There is a great deal of confusion regarding the instant claims with respect to their relationship to the elected species and the election is incomplete. This is elaborated upon below. Due to these problems/omissions, it is unclear which species is elected and the claim(s) that should be under examination in the instant case.  
The Election of Species Requirement mailed August 08, 2002 required election of a specific combinatorial library for which the core structure common to all library members is defined and an elected species of the newly added claims (Claims 18-22). Applicant election of species by electing a species for X and R and indicated that Claims 1-6, 18 and 19 read on the elected species, but the election is deemed to be incomplete and confusing. First, applicant was required to elect the core structure common to all library members (Claims 2-6) showing a specific nucleoside monomer (Claim 4), a specific spacer monomer (Claim 6), a specific cap monomer (Claim 5) and all the bonds between them. Further, applicant is required to elect a single species from the newly added claims with a specific defined X and R. The requirement is reiterated below:

Claim 1 is generic.

**Species of library**

A specific combinatorial library should be elected, for purposes of search, showing the nucleoside monomer, spacer monomer and cap monomer and all bonds between them. It is recognized that the claimed invention is a library and not a single compound; however, the core of the library should be defined. That is, the core structure common to all library members should be defined.

Newly added claims 19-22 define a plurality of different species of library with respect to the moieties denoted X and R; a

single selection for each of these entities should be made.

Applicant elected a species "where in X is hydrogen and R is -NHCOR1". Because this election is not entirely specific (as was required), it is impossible to determine what is the core structure common to all the library members with respect to the nucleoside monomer, spacer monomer and cap monomer and all bonds between them. How are the nucleoside monomer, spacer monomer and cap monomer situated in the core structure? What are the single selections for these entities? Further, applicant did not elect a species since "R1" of "-NHCOR1" is defined by a plurality of different species in which case a single selection for R was not made. Election of the core structure common to all the library members should be defined with a single, specific type for the nucleoside monomer, spacer monomer and cap monomer and a single selection of species from the newly added claims are required.

4. See 37 CFR 1.111. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on Increased Flex Schedule and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct  
November 25, 2002

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER